

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KLAUS HILBIG, MARCEL KAREL NELIS LIPLIJN, and
BIRGIT ZINT-SCHUESSLER

Appeal 2007-2039
Application 10/619,656
Technology Center 1700

Decided: August 30, 2007

Before CHUNG K. PAK, PETER F. KRATZ, and JEFFREY T. SMITH,
Administrative Patent Judges.

PAK, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 through 7, all of the claims pending in the above-identified application. We have jurisdiction pursuant to 35 U.S.C. § 6.

STATEMENT OF THE CASE

The subject matter on appeal is directed to a method for making a tissue product having a property defined by a functional language. Further details of the appealed subject matter are recited in representative claims 1 and 7 reproduced below:

1. A method for making a tissue paper product from a tissue paper web, said method comprising the steps of:

-passing said tissue paper web through an embossing nip formed between a first and a second embossing roll, wherein at least one of said embossing rolls comprises at least 30 embossing elements per square centimeter; and,

-applying a transferable lotion to at least portions of said tissue paper web such that said tissue paper product is adapted to transfer a first quantity of said transferable lotion upon stationary contact with a glass surface and transferring a second quantity of said transferable lotion upon dynamic contact with a glass surface, wherein said second quantity is at least 2 times greater than said first quantity.

7. A tissue paper product made according to claim 1.

As evidence of unpatentability of the claimed subject matter, the Examiner has relied upon the following references:

Kamps	US 5,702,571	Dec. 30, 1997
Luu	US 6,352,700 B1	Mar. 5, 2002

The Appellants' admission at pages 6 through 8 of the Specification (hereinafter referred to as "the admitted prior art").

The Examiner has rejected claims 1 through 7 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Luu and either Kamps or the admitted prior art. The Examiner has found that Luu teaches

applying a transferable lotion to a tissue paper which could be embossed (Answer 4). Recognizing that Luu does not provide the details of its embossing step, the Examiner has relied on Kamps or the admitted prior art to show that the claimed embossing step is well known (Answer 4 and 5). Based on these combined teachings, the Examiner has properly concluded that one of ordinary skill in the art would have led to form the embossed tissue paper taught by Luu in the manner taught by Kamps or the admitted prior art (Answer 5).

The Examiner has also found that the claimed functional property is present in Luu's tissue paper (Answer 5). However, the Appellants disagree with this finding (Br. 5-6). According to the Appellants, the prior art references relied upon by the Examiner do not teach or suggest forming a tissue paper having the claimed functional property, i.e., "said tissue paper product is adapted to transfer a first quantity of said transferable lotion upon stationary contact with a glass surface and transferring a second quantity of said transferable lotion upon dynamic contact with a glass surface, wherein said second quantity is at least 2 times greater than said first quantity" recited in claim 1 (Br. 5-6). The Appellants appeal from the Examiner's decision finally rejecting the claims on appeal under 35 U.S.C. § 103(a).

ISSUE

Do Luu's tissue product and the claimed tissue product appear to be identical or substantially identical and/or appear to be produced by identical or substantially identical processes?

FACTS, PRINCIPLES OF LAW, AND ANALYSIS

As held by the predecessor to our reviewing court in *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977):

Where....the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior products do not necessarily or inherently possess the characteristics of his claimed product....Whether the rejection is based on ‘inherency’ under 35 U.S.C. § 102, on ‘prima facie’ obviousness” under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products.

See also In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (While there is nothing inherently wrong with using a functional limitation, it does carry with it a risk; the burden is placed on the applicant to prove that the prior art product does not necessarily possess the claimed functional characteristic, when the claimed and prior art products appear to be identical or substantially identical.)

Here, the Examiner has demonstrated that the tissue product taught by Luu is either identical or substantially identical to the claimed product. Luu, like the Appellants, teaches a tissue product “prepared according to conventional processes (including TAD, CWP and variants thereof) known to those skill in the art.” Compare Luu, col. 4, ll. 21-42, with the Appellants’ Specification 3-6. In one embodiment of Luu’s invention, this tissue product is provided in an embossed form (col. 3, ll. 33-37). Implicit

in this teaching is that the tissue product, like the Appellants' tissue product, is conventionally embossed. Compare Luu, col. 3, ll. 33-37, with the Appellants' Specification 6-8. The lotionized tissue product taught by Luu, like the Appellants' lotionized tissue product, is obtained by treating or applying a lotion to either the embossed or unembossed substrate "according to conventional application methods known to those skilled in the art." Compare Luu, col. 3, ll. 33-37 and col. 4, ll. 42-46, with the Appellants' Specification 8-9. The lotion used in Luu, like that of the Appellants, "is transferable to the skin" and includes an emollient and a retention/release agent as base ingredients. Compare Luu, col. 1, l. 56 to col. 2, l. 1 and col. 6, ll. 29-42, with the Appellants' Specification 8.

Given the virtual or substantial identity between the claimed and prior art tissue products and processes of making the same, we concur with the Examiner that the burden is properly shifted to the Appellants to prove that Luu's tissue product does not possess the claimed functional property. This is especially true in this case since one of ordinary skill in the art would have had a reasonable expectation of transferring a significantly higher quantity of the lotion from Luu's tissue product upon dynamic contact (providing squeezing or pressurizing effect) than upon stationary contact.

On this record, the Appellants have not demonstrated that Luu's tissue product does not possess the claimed functional property. In fact, the Appellants' own data at page 9 of the Specification indicate that Luu's tissue product is more likely than not to have the claimed functional property.

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Accordingly, for the reasons set forth in the Answer and above, we affirm the Examiner's decision rejecting the claims on appeal under 35 U.S.C. § 103(a).

ORDER

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

sld/lis

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